

from the group of pointing devices comprising a mouse, a touch pad, a trackball, and a joystick.

15. (Unchanged) The pointing device of claim 12, wherein at least one of the at least one control comprises a control selected from the group of controls consisting of a button, a slider, and a wheel.

16. (Twice Amended) A pointing device for a computer comprising:
a first control coupled to the device, the first control associated with operating the computer;
a second control coupled to the device, the second control associated exclusively with operating a multimedia device through the computer, wherein the multimedia device is operatively coupled to the computer; and
wherein the second control of the pointing device is operable without regard to orientation of the pointing device.

17. (Unchanged) The pointing device of claim 16, wherein the pointing device is selected from the group of pointing devices comprising a mouse, a touch pad, a trackball, and a joystick.

18. (Unchanged) The pointing device of claim 16, wherein actuation of a control causes the computer to change a functionality of the multimedia device associated with the control.

REMARKS

The following remarks were originally submitted in Applicant's response dated January 24, 2001 to the final Office Action dated October 24, 2000, but were not entered because the Examiner stated that the amendments presented new issues requiring a further search. Reconsideration of these remarks is respectfully requested.

Claims 1, 8, 12, and 16 are amended. Claims 1-18 are now pending in this application.

§112 Rejection of the Claims

Claims 1, 8, 12 and 16 were rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims have been amended to clarify that the control for the multimedia device is what is operable without regard to the orientation of the pointing device. Thus, in a sense, at least a part of the pointing device is operable without regard to its orientation. Support for this amendment is found at least in the teaching that the control for the multimedia device includes "buttons, wheels, sliders, etc." at column 14, lines 9-10 combined with the fact that an RF transceiver is used to communicate at column 9, lines 20-21. It is well known that buttons, sliders, wheels and RF transceivers do not require a particular orientation to operate. As the amendments do not add new matter, do not introduce new issues, and move the application forward, it is requested that they be entered.

§103 Rejection of the Claims

Claims 1-18 were rejected under 35 USC § 103(a) as being unpatentable over Frank (EP Patent No. 1 596 594) in view of Redford (U.S. 5,339,095). This rejection is respectfully traversed at least on the basis that all of the elements are not shown or suggested by the combination of the references and that there is no suggestion to combine the references to solve a similar problem. Thus, no *prima facie* case of obviousness has been established, and the rejection should be withdrawn.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the court in *In re Fine*:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. (BNA) 293, 298 (Fed. Cir. 1985).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985). The Examiner can only rely on references which are either in the same field as that of the invention, or if not in the same field, must be "reasonably pertinent to the particular problem with which the inventor was concerned." *M.P.E.P.* § 2141.01 (a) (citing *In re Oetiker*, 24 U.S.P.Q.2d (BNA) 1443 at 1445). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568

(Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Finally, the Examiner must avoid hindsight. *Id.* The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

The present invention solves a problem of how to control multiple multimedia devices attached to a computer without having to have a remote control directly communicate with each multimedia device. Further, the present invention provides separate buttons that are directed toward controlling the multimedia devices, but again, through the computer. Thus, the remote only needs to communicate with the computer in order to effectively control the multimedia devices, and cumbersome cursor control devices are not required to control the multimedia devices.

Frank describes a remote control device for a computer, that also can be switched to operate as a control device for other target devices, communicating directly with them, Column 4, lines 11-13, not through the computer, as must occur in the presently claimed invention: "wherein the pointing device only couples to the computer..." This element describes a fundamental difference from Frank. Frank simply describes the combination of two remote control devices into a single remote control device to directly control separate devices. Switching the remote effectively selects the "other" remote to control a different device directly. The problem solved by Frank is that of reducing the number of remote control devices, wherein devices are still directly communicated with via the remote. It was also not directed at the problem of eliminating cumbersome cursor control devices.

Redford describes a remote control device for a multimedia computer system. It does not describe a control device for "a multimedia device operatively coupled to the computer" as claimed in claim 1. Further, the command buttons that were referred to in the office action, mouse buttons 40 and 42 are simply mouse buttons. They are not "at least one control to control only the multimedia device" as claimed in claim 1. They are mouse buttons, for selecting things pointed to by a cursor. Redford also describes a trigger, but that also operates like a mouse button. Col. 4, lines 10-12. Since Redford does not describe multimedia devices operatively

coupled to a computer, nor does it describe controls for such devices to directly control them, it also does not address a similar problem as the present invention.

Even if Frank and Redford are combined, the presently claimed invention is not achieved. There is no teaching or suggestion in either with regard to controlling both a computer, and a separate multimedia device while only being operable coupled to the computer. There are no multimedia devices separate from a multimedia computer described in Redford. Further, there is no teaching or suggestion of how to solve the problem of controlling multimedia devices attached to a computer, by only having a remote control device operatively coupled to the computer, and not relying on cumbersome cursor control devices. Hindsight, using the current application as a template, is the only way that the references could be combined.

Claims 1, 8, and 16 contain similar elements regarding controlling separate multimedia devices through the computer, without the need to directly control the multimedia devices. They also recite that the controls for the multimedia devices are operable without regard to the orientation of the pointing device. Claim 12 also recites that the control controls only the multimedia device through the computer. Frank and Redford suggest no such thing. While Redford refers to a multimedia computer, it does not refer to multimedia devices being operably coupled to the multimedia computer that can be controlled by dedicated control buttons that operate without regard to the orientation of the pointing device.

Since there is no teaching or suggestion of each and every element, a prima facie case of obviousness has not been established, and the rejection of each claim should be withdrawn. The dependent claims are also believed patentable because they depend on a claim that is believed allowable.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

PRELIMINARY AMENDMENT

Serial Number: 08/904,056

Filing Date: July 31, 1997

Title: AUDIO AND VIDEO CONTROLS ON A POINTING DEVICE FOR A COMPUTER

Page 9

Dkt: 450.156US1

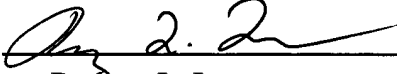
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

TODD D. LINDSEY

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date March 26, 2001 By 
Rodney L. Lacy
Reg. No. 41,136

"Express Mail" mailing label number: EL 721274993 US

Date of Deposit: March 26, 2001 (Monday)

This paper or fee is being deposited on the date indicated above with the United States Postal Service pursuant to 37 CFR 1.10, and is addressed to the Commissioner for Patents, Box CPA, Washington, D.C. 20231.